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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Atsuya KUME

Serial No. 09/367,829

Filed: August 23, 1999

For: RADIO COMMUNICATION
SYSTEM

) **BEFORE THE BOARD OF PATENT
) APPEALS AND INTERFERENCES**

)
) Appeal No.:

)
) Examiner: Lana Le

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) Group Art Unit: 2684

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) November 27, 2002

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REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is a reply pursuant to 37 CFR § 1.193(b)(1) to the Examiner's Answer dated October 1, 2002. As shown below, the Examiner's Answer fails to establish that the claims are properly rejected, because the Answer fails to properly consider the disclosure of the relied-upon prior art vis-a-vis properly construed claim language. Instead of applying the properly construed claim language to the teaching of the prior art, the Answer broadly construes the language of the prior art and applies it to the claims.

With respect to claim 8, the Examiner's Answer has failed to establish a case of anticipation under 35 U.S.C. § 102. At page 4 of the Answer, the Examiner alleges that

the Balachandran reference lowers the default threshold “when a handover operation is unsuccessfully executed.” Claim 8 does not claim lowering a default threshold “when a handover operation is unsuccessfully executed.” Claim 8 requires a control unit to lower at least one default threshold **when said handover operation fails to transfer said call to another base station.**

As explained in Appellant’s main brief on appeal, Balachandran does not teach the adjustment of a threshold when a handoff operation fails to transfer a call to another base station, as disclosed and claimed in the present invention, but instead adjusts a threshold when the newly acquired channel fails to meet the established threshold levels after a number of successive acquisitions of it. Clearly, Balachandran cannot test the thresholds of the channel unless the channel has been acquired. This is unambiguously disclosed at step 2005 of Fig. 20, wherein threshold testing is performed only where “synch” has been successfully established with the new channel. As such, there is no threshold adjustment in Balachandran where the handoff procedure fails to transfer a call to another base station as taught and claimed in the present application.

At pages 8 and 9, the Examiner continues to adhere to the position that Appellant’s arguments are somehow not commensurate with the claims, or are directed to features not stated in the claims. This is not the case, as clearly explained in the main brief on appeal at page 8. Moreover, the Examiner’s Answer itself demonstrates that the Examiner’s position is erroneous because it inverts Appellant’s argument.

In particular, the Answer mischaracterizes Appellant's argument with respect to the meaning of the claim language requiring a lowering of at least one of two default thresholds "when said handover operation fails to transfer said call to another base station." The Answer erroneously seems to state that no channel needs to be acquired in the Balachandran apparatus for changing the threshold value, "while it is required by appellants' claim 8." The Examiner's assertion is wrong, because successful channel acquisition is required in Balachandran before any threshold adjustment is carried out. In contradistinction, according to the present invention as disclosed and claimed, threshold adjustment is performed when there is a failure to transfer a call to another base station. Therefore, "whether the reference includes those features or not" is clearly not irrelevant as asserted in the Examiner's Answer, but to the contrary, conclusively establishes the absence of any anticipation under 35 U.S.C. § 102.

At page 9, the Examiner's Answer asserts again that Balachandran teaches adjustment of a threshold "when handoff fails," relying on column 23, lines 30-65. However, the passage at column 23, lines 30-65 is a summarization of the detailed description of third embodiment of Balachandran, beginning at column 24, line 18, with the discussion of Fig. 17 (see col. 7, ll. 55-57, describing Fig. 17 as illustrating the third embodiment of the invention). It is error, in determining whether a prior art reference discloses the limitations of a claim, to eschew an analysis of what is actually taught by the reference in favor of reliance on an interpretation of broad summary language intended to capsule the detailed description.

The Examiner's Answer has reversed the rules of claim examination. It is axiomatic that claims under examination are to be given their broadest reasonable meaning in light of the specification as would be construed by those skilled in the art, and that the prior art is to be considered as a whole in light of the knowledge of those of ordinary skill in the art for what it teaches to those of ordinary skill in the art.

Instead of following these established principles, the Examiner's Answer improperly construes the language of the prior art in its broadest possible sense, so as to "cover the limitations" as set forth in the claims. In particular, it is well established that an analysis of the prior art must focus on what the prior art teaches to those skilled in the art, and not on the breadth of terminology used in the reference, in determining whether a prior art reference discloses a claimed invention. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

CONCLUSION

In view of the foregoing and the arguments presented in the main brief on appeal, claims 8-10, 12, 13, 19-21, 23 and 24. are submitted to be directed to a new and unobvious radio communication system, which is not taught or suggested by the prior art. The Honorable Board is respectfully requested to reverse all grounds of rejection and to direct the passage of this application to issue.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to
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Respectfully submitted,

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